

## **REMARKS**

Claims 1, 2, 6-9, 19, 20, 32-34, 43-45, 48-50, 56 and 57 are all the claims pending in the application. Claims 33-59 are rejected on statutory grounds and on prior art grounds. Applicant respectfully traverses these rejections based on the following discussion.

### **I. Rejections under 35 U.S.C. § 102(b)**

Claims 1-2, 6-9, 19, 20, 43-45 and 48-50 are rejected under 35 U.S.C. § 102(b) as being anticipated by Klesa (U.S. Patent 2,998,008).

Independent claim 1 recites “wherein said body contacting surface is loosely coupled to human skin to allow ease of movement” in the last two lines. Klesa, in contrast, describes a “restraining device” for “restraining the movement of the arms and legs of patients” (col. 1, lines 7-9. Such a restraining device, is not “loosely coupled to human skin to allow ease of movement” as recited in claim 1. Therefore, it is submitted that claim 1 as well as dependent claims 2, 6-9, 19, 20, and 31, which depend therefrom, are patentably distinguishable over Klesa. Withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

Independent claim 43 recites “wherein said body contacting surface is loosely coupled to human skin to allow ease of movement” in the last two lines. Klesa, in contrast, describes a “restraining device” for “restraining the movement of the arms and legs of patients” (col. 1, lines 7-9. Such a restraining device, is not “loosely coupled to human skin to allow ease of movement” as recited in claim 43. Therefore, it is submitted that claim 43 as well as claims 44, and 48-50 are patentably distinguishable over Klesa. Withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

## I. Rejections under 35 U.S.C. § 103(a)

Claims 32 and 56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Klesa in view of Bartlett (U.S. Patent 6,155,999). In addition, claims 33, 34 and 57 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Klesa.

Claims 32, 33 and 34 each depend on claim 1 and incorporate all the features of claim 1 by reference. Moreover, claims 56 and 57 each depend on claim 43 and incorporate all the features of claim 43 by reference. For the reasons discussed above, it is submitted that claims 32-34, 56 and 57 are each patentably distinguishable over Klesa. In addition, nothing has been found or cited in Bartlett that cures the deficiencies of Klesa described above. In addition, the Final Office Action indicates the parameters recited in claims 33, 34 and 57 would be obvious to one of ordinary skill in the art, but fails to provide any evidence of that assertion and fails to cite any authority for its assertion. Therefore, it is submitted that claims 32-34, 56 and 57 are patentably distinguishable over Klesa and Bartlett, alone or in combination.

As discussed in detail above, the proposed combination of the references does not appear to include all of the above claim limitations therefore, *prima facie* obviousness has not been established.

Mere conclusory statements cannot sustain rejections on obviousness; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness (MPEP 2141 III). However, the proposed combination of references does not have all the elements for the presently claimed invention. The Office Action does not explain why the elements missing from the proposed combination would have been obvious to one ordinary skill in art. Therefore, the Office Action does not support the rejection under 35 U.S.C. § 103 with a

clear articulation of the reason(s) why the claimed invention would have been obvious in view of the cited references.

For any of these reasons, the aforementioned feature of independent claim 33, 40, 46 and 53 cannot reasonably be said to be present in the asserted combination. The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103, despite any recent revision to the Manual of Patent Examining Procedure (MPEP). Section 2143.03 of the MPEP requires the “consideration” of every claim feature in an obviousness determination. To render the Applicant’s claims unpatentable, however, the Office must do more than merely “consider” each and every feature for this claim. Instead, the asserted combination of the cited prior art must also teach or suggest *each and every claim feature*. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *See In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). Indeed, Applicant submits that this is why Section 904 of the MPEP instructs Examiners to conduct an art search that covers “the invention

*as described and claimed.*" (emphasis added). Lastly, Applicant respectfully directs attention to MPEP § 2143, the instructions of which buttress the conclusion that obviousness requires at least a suggestion of all of the features of a claim, since the Supreme Court in *KSR Int'l v. Teleflex Inc.* stated that "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). In sum, it remains well-settled law that obviousness requires at least a suggestion of all of the features in a claim. *See In re Wada and Murphy*, *citing CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

In view of the foregoing, the Applicant respectfully submits that the features defined by independent claims 1 and 43 contain patentable subject matter and as such, claims 1 and 43 are patentable over the prior art of record. Further, dependent claims 2, 6-9, 19, 20, 32, 33, 44, 45, 48-50, 56 and 57 are similarly patentable not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Moreover, the Applicant notes that all claims are properly supported in the specification and accompanying drawings, and no new matter is being added to the application. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

#### **IV. Formal Matters and Conclusion**

With respect to the rejections to the claims, the claims have been amended, above, to overcome these rejections. In view of the foregoing, the Examiner is respectfully requested to

reconsider and withdraw the rejections to the claims.

In view of the foregoing, Applicants submit that claims 1, 2, 6-9, 19, 20, 32-34, 43-45, 48-50, 56 and 57, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 50-4744.

Respectfully submitted,

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